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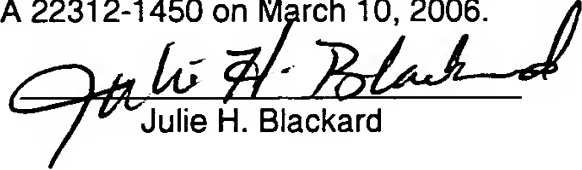
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JPL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE	
REPLY TO EXAMINER'S ANSWER DATED 01-10-06	Atty. Docket No. VIGN1690-1

Applicant Dean Moses	
Application Number 10/091,513	Filed 03/07/2002
Title Method and System for Sharing Different Web Components Between Different Web Sites in a Portal Framework	
Group Art Unit 2152	Examiner Dinh, Dung C.
Confirmation No. 8808	

**Mail Stop: Appeal**  
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Dear Sir:

<p align="center"><b><u>Certification Under 37 C.F.R. §1.10</u></b></p> <p>I hereby certify that this document is being deposited with the United States Postal Service as Express Mail <b>Label No. EV772014309US</b> to Addressee in an envelope addressed to: Mail Stop: Appeal, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22312-1450 on March 10, 2006.</p> <p align="center"> Julie H. Blackard</p>
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Appellant presents this Reply to the Examiner's Answer to the Appeal Brief mailed on January 10, 2006. Appellant respectfully requests that this Reply to the Examiner's Answer be considered in this appeal by the Board of Patent Appeals and Interferences.

### **Reply to Examiner's Answer**

#### **1. Introduction**

The Examiner responded to the Appeal Brief filed by the Appellant on November 28, 2005 ("Appeal Brief") with the Examiner's Answer to the Appeal Brief of January 10, 2006 ("Examiner's Answer"). In the Examiner's Answer the Examiner attempts to characterize the issues in this appeal as twofold: a) is Stefik's ticket a reference to an object and b) is providing an invokable software object as a digital work an obvious variation of Stefik's teaching? (See Examiner's Answer, Page 6)

This characterization is, however, an oversimplification and misstatement of the issues before the Board in this appeal. The Examiner rejected all of the claims in the application under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,236,971 ("Stefik") and Publication No. 2002/0078377 ("Chang"). In order to establish a prima facie case of obviousness, the Examiner must show that three criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. 2143.

Thus, the issues are more broadly, and correctly, defined as: a) do Stefik and Chang teach all the limitations of the invention, and b) would a person of ordinary skill in the art have combined references as suggested by the Examiner.

#### **2. Not All Limitations Disclosed**

Independent Claim 1 of the Application recites "storing a reference to an object in a first repository, wherein the object is an invokable software object, performing a first operation to store a duplicate of the reference to the object in a second repository, wherein the first operation is in accordance with a first privilege granted as defined by a permission." Independent Claim 27 recites "a first repository operable to store a reference to an object wherein the object is an invokable software object, and a second repository operable to store a duplicate of the reference to the object in response to a first operation, wherein the first operation is in

accordance with a first privilege granted as defined by a permission.” Independent Claims 14 and 44 recite similar limitations. Thus, each of these independent Claims shares the elements of storing a reference to an object in a first repository and storing a duplicate of the reference to the object in a second repository. Furthermore, each shares the common recitation that the operation to store the duplicate is in accordance with a privilege.

The term “reference to an object” as used in the art, is understood to mean a reference that points to the location of an object in a database or file system and identifies the object type, (for example, a pointer). Based on the reference to the object, a programmatic user associated with a site can find the object and invoke an instance of the object. The present invention is drawn to the duplication of the reference to an object from a first repository to a second repository. If a site has access to the second repository, the site will be able to locate the referenced object and invoke an instance of the object based on the duplicated reference to the object, even without access to the first repository. Access to objects can be controlled by requiring that duplication of a reference to an object occur according to a set of permissions. For example, a first site wishing to share an object A, which is referenced in a first repository associated with object A, can only duplicate the reference to a second repository associated with a second site if the first site has privileges to add references to the repository of the second site. If the reference is duplicated to the repository of the second site, the second site can invoke an instance of object A, even without access to the repository of site A. This allows for more efficient administration of multiple sites that require access to common objects.

The Examiner equates the digital ticket of Stefik to the reference to the invokable software object of Claims 1, 14, 27 and 44 of the Application. The Examiner disagrees with the Appellant’s definition of the term “reference to an object” as defined above, stating that the Examiner will use the ordinary definition of a reference, e.g. to refer to, to designate, identify or associate (See Examiner’s Answer, Page 6). While it is difficult for Appellant to discern the difference between the Examiner’s definition and the ordinary use of the term “reference to an object” in the art, even assuming arguendo the Examiner’s definition of reference, the digital ticket of Stefik does not function as a reference to an object.

The Examiner asserts that:

“Stefik teaches the holder of a digital ticket is entitled to certain usage rights with respect to a digital work. Stefik defines ‘usage rights’ as ‘rights granted to a recipient of a digital work...these rights define how a digital work can be used and if it can be further distributed’ (col. 6 lines 46-59). It is implicit that a digital ticket issued for a particular digital work and can only be used for access to that particular digital work.” (See Examiner’s Answer, Page 7).

The Examiner goes on to state that because the digital ticket may be used for prepaid upgrades or to make copies of a digital work that the

“digital ticket cannot be a generic ticket for upgrade or copy [sic] any work in the repository. The ticket implicitly only permit [sic] the holder to upgrade or make copies of the work originally purchase the digital ticket inherently must contain some information to associate it with a particular work in order to ensure that the ticket is applied to the right work...Hence the ticket is a reference to an object.” (See Examiner’s Answer, Page 7-8).

Applicant respectfully disagrees, it is neither implicit that the digital ticket of Stefik is issued for a particular work, nor it is inherent that a digital ticket is associated with a particular work. In fact, the digital ticket of Stefik is not issued for a particular digital work and is not associated with a particular digital work. As such, the digital ticket of Stefik does not function as a “reference to an object”, and Stefik and Chang do not teach all the limitations of the invention.

## **2.1 It Is Not Implicit that a Digital Ticket is Issued for a Particular Work**

The Examiner cites Col. 4, Lines 6-15 40-45 and Col. 6, Lines 46-59 of Stefik for his assertion that a digital ticket is issued for a particular digital work and can only be used for access to that particular digital work.

Col. 4, Lines 6-18 of Stefik recite:

“A system for controlling the distribution and use of digital works using digital tickets is disclosed. A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service. In the present invention, a “digital ticket” is used to enable the ticket holder to exercise usage rights specifying the requirement of the digital ticket. Usage rights are used to define how a digital work may be

used or distributed...A usage right may specify a digital ticket which must be present before the right may be exercised.”

Col. 4, Lines 40-49 of Stefik recite:

“A digital ticket may be used in many commercial scenarios such as in the purchase of software and prepaid upgrades. A digital ticket may also be used to limit the number of times that a right may be exercised. For example, a user may purchase a copy of a digital work, along with the right to make up to 5 Copies. In this case, the Copy right would have associated therewith a digital ticket that can be punched up to 5 times. Other such commercial scenarios will become apparent from the detailed description.”

Col. 6, Lines 53-55 of Stefik recite:

“The term ‘Usage Rights’...is a term which refers to the rights granted to a recipient of a digital work...these rights define how a work can be used...”

In contrast to the assertions of the Examiner, none of the above passages discloses that a digital ticket can only be used for access to a particular digital work. In fact, these passages imply the opposite. If, as recited in the above passages, a digital ticket is used to enable a user to exercise usage rights specifying the digital ticket, and these usage rights are attached to digital works to determine what transaction can be successfully carried out for a digital work (See Stefik, Col 17, Lines 52-56), it would seem that the same digital ticket can be specified by usage rights attached to multiple distinct digital works.

More specifically, usage rights are attached to a digital work. In fact “it is fundamental to Stefik that usage rights are treated as part of a digital work.” (See Stefik, Col 11, Lines 33-34) As discussed above, a digital ticket entitles a user to exercise some usage right, and each usage right may specify a digital ticket which must be present before the right may be exercised. Put another way, a digital ticket may be required by a usage right. Thus, usage rights are associated with digital works and usage rights are associated with, or specify, digital tickets. In other words, digital tickets are not associated with digital works, as the Examiner asserts, instead digital works are associated with usage rights and these usage rights are associated with digital tickets. Given this, it only makes sense that if the same usage right were associated with more than one digital work, a digital ticket specified by this usage right could be utilized to

obtain that usage right for any of the digital works associated with that usage right. Therefore, digital tickets are not associated with a specific digital work as asserted by the Examiner.

It is helpful to explore the above concept in more detail. Stefik states that usage rights are permanently attached to a digital work. (See Stefik, Col. 6, Lines 60-62, Col 9, Lines 14, Col. 11, Lines 33-34, Col. 51, Lines 27-28) These usage rights define how a digital work can be used. (See Stefik, Col 51, Lines 22-25) Copies of a particular digital work (which themselves are digital works) may be made such that copies of a particular digital work reside in each of two or more distinct repositories. (See Stefik, Col. 11, Lines 16-43) As the digital work is distributed, the scope of the usage rights attached to the digital work will remain the same or be narrowed. (See Stefik, Col. 11, Lines 34-36) Thus, copies made of the digital work will also have usage rights attached. (See Stefik, Col 6, Lines 60-61)

More specifically, when a digital work is copied, if a next-set of rights has been provided those rights are transmitted as the rights for the copy of the work. Otherwise, the rights of the original work are transmitted as the rights for the copy of the work. (See Stefik, Col. 11, Lines 53-56, Col. 34, Lines 31-37) Thus, multiple copies of a digital work (each copy being itself a digital work) may exist in distinct repositories, where each of the copies has identical usage rights. As a usage right specifies a digital ticket which must be present before the right may be exercised, it seems a logical conclusion that each of these identical usage rights (each of which is associated with a distinct digital work) may specify the same digital ticket (or same type of digital ticket) and consequently that one digital ticket can be utilized to exercise the usage right attached to any one of the distinct copies of a digital work. Thus, usage rights may be exercised with respect to one of a set of distinct digital works using a single digital ticket. As can be seen then, this observation directly contradicts the Examiner's belief that a digital ticket can only be used to access a "particular digital work".

Additionally, the above passages state that a ticket may be used in many commercial settings such as purchase of software and pre-paid upgrades. Thus, a digital ticket may be used to exercise usage rights with respect to digital works (such as software upgrades) which may be produced in the future. It would therefore be difficult to associate a digital ticket with a particular digital work, if the digital ticket can be utilized for works which have not yet been produced, or may never be produced.

## 2.2 It is Not Inherent that a Digital Ticket is Associated with Digital Work

The Examiner has also asserted that it is inherent that there must be some type of identification or reference associating the ticket to the particular digital work. As recited in M.P.E.P 2112:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)"

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxial oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency)."

The Examiner has provided no basis in fact or technical reasoning that reasonably supports the determination that it is inherent that there must be some type of identification or reference associating the ticket to the particular digital work. In fact, as explained in more detail above and below, there are plausible interpretations of Stefik where there is no identification or

reference associating the ticket to the particular digital work. As such, it is not the case that it is necessary that there be some type of identification or reference associating the ticket of Stefik with a particular digital work. Consequently, the Examiner is incorrect in asserting that it is inherent that there must be some type of identification or reference associating the ticket to the particular digital work.

### **2.3 Reference to an Object Not Disclosed in Stefik**

The Examiner's logic with respect to the disclosure of a reference to an object in Stefik can be distilled and summarized as follows: it is implicit that a digital ticket is issued for a particular work and can only be used to access that digital work, and it is inherent that there must be some type of identification or reference associating the digital ticket to the work. The conclusion can therefore be reached that the digital ticket is a reference to an object. However, the above passages do not support the Examiner's assertion that a digital ticket has specific rights to only a particular digital work, or that a digital ticket is associated with a particular work. Furthermore, the Examiner offers no other cites or proof that a) the digital ticket is issued for a particular work, b) that a digital ticket can only be used to access that digital work or that c) there must be some type of identification or reference associating the ticket to match the ticket to the work.

As can be seen, then, the Examiner is utilizing circular logic. By assuming, without support, that a) it is "implicit" that the digital ticket is issued for a particular work, b) that it is "implicit" a digital ticket can only be used to access that digital work and that c) it is "inherent" that there must be some type of identification or reference associating the ticket to match the ticket to the work, the Examiner reaches the desired conclusion that the ticket is a reference to an object, even though Stefik neither teaches, suggests nor implies that the digital ticket is a reference to an object.

Furthermore, the Examiner asserts that because Stefik discloses a prior art system where a physical voucher card has enough information to identify a purchased book, and there is no evidence that Stefik considers the identification to a specific work to be a problem or is undesirable, it is inherent that Stefik's digital ticket still retains the indication to the work. (See Examiner's Answer, Page 8-9) Appellant respectfully submits that this logic is also flawed. Encapsulated, this logic can be summarized as follows: a prior art system mentioned in Stefik



discloses a physical voucher that identifies a work, Stefik does not explicitly state that this is a problem or is undesirable, therefore it is inherent that a digital ticket of Stefik “retains” the indication to a work. Thus, the Examiner has used an omission to obtain a positive recitation: Stefik doesn’t mention that it would be undesirable to have a physical device contain a reference to a work, therefore is inherent digital ticket of Stefik is a reference to an object. Additionally, as discussed above, inherency requires that a characteristic necessarily flows from the teachings of the applied prior art. Appellant respectfully submits that a digital ticket being a reference to an object does not necessarily flow from Stefik’s failure to explicitly state that identification of a work is a problem or is undesirable.

The Examiner’s arguments notwithstanding, as explained in Applicant’s Appeal Brief, there is no teaching or suggestion in Stefik that a particular work can be located in a database from the contents of the digital ticket, that a digital ticket can only be used to access a specific digital work, that there is some type of identification or reference associating the ticket with a digital work, that a software object can be invoked using a digital ticket, or that the digital ticket functions as a “reference to an object” as that phrase is used in the art.

More specifically with reference to Stefik and as recited in the Appeal Brief, during a copy operation the requester sends a server a message to initiate a “Copy Transaction”. (See Stefik, Col 34, Lines 16-43) The message indicates the work to be copied, the version of the copy right to be used for the transaction, the destination address information for placing the work and the number of copies requested. (See Stefik Col. 34, Lines 23-28) If the work requires a ticket, a ticket may be given and punched by a distributor the work is then copied to the requestor’s repository. (See Stefik Col. 46, Lines 45-50). Thus, the desired work must be pointed out with specificity in a message from the requestor, and a ticket submitted separately. These types of tickets are not specific to the digital work requested, and a ticket may be used in transactions with more than one digital work.

An analogy may be made to purchasing tickets at a fair. When one arrives at a fair a number of generic tickets may be purchased. These tickets may be used for a variety of things within the fair, despite the fact that the tickets contain no references to those things. For example, the tickets may be used to ride the Ferris wheel, or the tilt-a-whirl. Additionally, these tickets may be used to purchase funnel cake or cotton candy. Thus, when a ride or food item is

desired it must be identified separately, after a ticket can be presented in order to obtain the ride or food item. Thus, though those tickets contain no reference to a particular good or service they are necessary to obtain these goods or services. Additionally, the same ticket may be used to obtain a variety of goods or services.

The Examiner refutes this analogy, stating that:

“this would not be conforming to the teaching of Stefik...[which] teaches that digital ticket [sic] may be used for prepaid upgrades or number of time [sic] to make copies of a digital work. Clearly the digital ticket cannot be a generic ticket for upgrade [sic] or copy any work in the repository. The ticket implicitly only permit [sic] the holder to upgrade or make copies of the work originally purchased. The digital ticket inherently must contain some information to associate it with a particular digital work in order to ensure that the ticket is applied to the right work.” (See Examiner’s Answer, Page 7-8)

Again, the Examiner’s logic seems suspect. By assuming, without support, that a) it is “clear” that the digital ticket cannot be a generic ticket to upgrade or copy any work in the repository the Examiner draws the erroneous inference b) that it is “implicit” a digital ticket only permits the holder to upgrade or copy a particular work. From that erroneous inference the Examiner draws another erroneous inference that c) the ticket “inherently” must contain some information associating the ticket to match the ticket to the work, finally reaching the desired conclusion that the ticket is a reference to an object, even though Stefik neither teaches, suggests nor implies that the digital ticket is a reference to an object.

However, as discussed above, it is not the digital ticket that is associated with a digital work. Instead usage rights are associated with the digital works, and these usage rights specify digital tickets. Thus, even assuming that that the digital ticket cannot be a generic ticket to upgrade or copy any work in the repository, it is not implicit that a digital ticket only permits the holder to upgrade or copy a particular work and only that work, or that the digital ticket contains a reference to that digital work. A digital ticket may be used to exercise any usage right that specifies that digital ticket. If an identical usage right is attached to more than one digital work the same digital ticket can be utilized to exercise the usage right with respect to any one of the distinct copies of a digital work. As such, it is not implicit that a digital ticket only permits the holder to upgrade or copy a particular work. And, because it is not “implicit” in Stefik that a

digital ticket only permits the holder to upgrade or copy a particular work, it is not “inherent” that the digital ticket must contain some information associating the ticket to match the ticket to the work. Consequently, the Examiner’s conclusion that “the ticket is a reference to an object” is erroneous.

To continue with the fair analogy, when one arrives at a fair a number of generic tickets may be purchased for food items and for rides. The tickets for food items may be purple while the tickets intended for rides may be red. Neither the purple food tickets nor the red ride tickets contain reference to the food or rides which may be accessed with these tickets. The tickets may be used for a variety of things within the fair, despite the fact that the tickets contain no references to those things. For example, the red tickets may be used to ride the Ferris wheel or the tilt-a-whirl, while the purple tickets may be used to purchase funnel cake or cotton candy. When a ride or food item is desired it must be identified, after which a properly colored ticket can be presented in order to obtain the ride or food item. Thus, the usage of food or rides may be restricted based on the type of ticket (red or purple), however, the same type (red or purple) of ticket may be used to gain access to a variety of items without specifying any of these items. For example, a purple ticket may be used to purchase a churro, a funnel cake, a turkey leg, etc.

The ability to utilize a ticket for a variety of digital works makes perfect sense for a system designed for the distribution of digital works. For example, it is a much more effective system if a user is allowed to purchase a digital ticket for a movie which can then be redeemed for any movie which a user desires at a particular time as opposed to purchasing a digital ticket for one specific movie which may only be redeemed for that particular movie. Additionally, if the digital ticket of Stefik identifies a particular work, the system of Stefik would be highly inefficient. During initiation of a transaction of Stefik, a digital work is identified. The digital ticket can be submitted later, as described above. This arrangement, however, makes little sense if the digital ticket identifies the digital work. It would seem to be much more efficient to just send the digital ticket and utilize the digital ticket itself to identify the work. After all, why include identifying information in a digital ticket unless that identifying information is actually going to be used to identify the digital work?

As the digital ticket of Stefik does not point to the location of an object in a database or file system, does not identify an object type and does cannot be used to invoke an object, but

instead is used to obtain usage rights to an already identified work, the digital ticket of Stefik is not a reference to an invokable software object. Accordingly, Appellant respectfully submits that the Examiner has not pointed out where storing a duplicate of a reference to an object as recited in independent Claims 1, 14, 27 and 44 can be found in Stefik.

### **3. Examiner's / Appellant's Positions Regarding Obviousness**

The Examiner asserts that the present invention is obvious from the combination of Stefik's system for the distribution of digital media described above and the distributed computer system of Chang. The Examiner incorrectly asserts that the combination of the Stefik reference and the Chang reference teaches all the limitations of the invention in question, and that a person of ordinary skill in the art of the invention would have combined Stefik's distribution of digital media reference with the distributed computer system reference of Chang to arrive at the invention. More specifically, the Examiner says the rejection is based on the fact that an invokable software object was known at the time of the invention (as disclosed by Chang) and that providing an invokable software object as a digital work would have been an obvious variation of Stefik's teaching.

In the Examiner's Answer the Examiner has simply reiterated his position with regard to the combination of the Stefik and Chang references without responding or acknowledging Appellant's arguments (repeated below for the convenience of the Board). As argued in the Appeal Brief, the Appellant believes that the Chang reference is from the distributed computer system arts while the Stefik reference is taken from the digital media distribution arts, that these arts are distinct, and that a person of ordinary skill in the art of portal frameworks would not have combined references from these two domains to obtain the invention as suggested by the Examiner. The Applicant is not suggesting the physical integration of the systems of Stefik and Chang to refute the Examiner's assertions, but instead that there is no teaching or motivation to apply the system of Stefik to the software object of Chang and that additionally, even if one was to utilize the system of Stefik in conjunction with the software object disclosed in Chang the result would be large, unwieldy and unsuitable for its intended purpose.

### **3.1 Examiner's Reasoning**

The Examiner stated in the Office Action of July 17<sup>th</sup>, 2004 ("Paper 18") that Stefik teaches the invention, except that Stefik does not specifically disclose the object being an invokable software object. More specifically the Examiner has stated that "Chang is used merely to shown [sic] that it is known in the art to provide programs in object forms and to lease computer resources." (See Paper 18, Page 1) The Examiner further states that "given the teaching of Stefik, it would have been obvious of one of ordinary skill in the art to apply the teaching of Stefik to control the leasing of software objects" (See Paper 15, Page 3-4) In other words, the Examiner believes it would be obvious simply to take the system of Stefik and utilize it for controlling the leasing of invokable software objects and other system resources.

The Examiner attempted to show motivation for this change by stating that "it would have been obvious...because it would have enabled the owner of a software object to specify usage and distribution rights to the software object." (See Paper 15, Page 3, Last Paragraph)

### **3.2 Flaws In The Examiner's Reasoning Regarding Combination of Stefik and Chang**

The fallacy of the Examiner's reasoning that it would be obvious simply to take the media distribution method of Stefik and apply it to the invokable software objects of Chang is apparent from the fact that there are different distribution and usage patterns for the digital works of Stefik and the invokable software objects of Chang. For example, the digital works of Stefik, including audio, video and electronically published material, may be eventually distributed to human users who may have need to further distribute this digital work to other human users. In contrast, Chang is directed to a methodology for managing leases on system resources where these resources do not need to be further distributed to another recipient, and cannot be duplicated, replicated, or have multiple simultaneous users without defeating the purpose of Chang. Thus, the needs for the distribution system of Stefik differ drastically from the needs for managing system resources of Chang. The system of Stefik must manage the copy and distribution of multiple copies of a duplicable digital work while Chang arranges the serial use of non-duplicable system resources. Because of these factors, a system for distribution of media cannot be translated and applied to a system for the distribution of system resources, nor is it obvious that such a system would even be applicable to the distribution of system resources.

Further, in regard to the Examiner's assertion that the combination of Stefik and Chang "would have been obvious...because it would have enabled the owner of a software object to specify usage and distribution rights to the software object," the Appellant will explain below how applying Stefik to distribute system resources would render the resulting system for the distribution of system resources overly complex and exceedingly expensive due to the high overhead costs imposed.

### **3.3 Applying the System of Stefik to the Resources of Chang would Result in Needless Complexity**

Despite the Examiner's assertion that it would be desirable to apply the invention of Stefik to invokable software objects to enable the owner of an invokable software object to specify usage and distribution rights to a software object, utilizing the invention of Stefik to control access to invokable software objects would create a system with a needlessly complex overhead that would be detrimental to the operation of the system.

More specifically, Stefik refers to usage rights of various digitally encoded works, including audio, video and electronically published material. These digital works are eventually distributed to human users who may have need to further distribute the digital work to other human users. Thus, human users are granted access to these digital work using digital tickets. This may be simultaneous access to a digital work, or copies of the digital work. To control this access, in the usage rights of Stefik are attached directly to digital works (See Stefik Col. 9, Lines 14-16). This may be implemented through the use of a description tree which contains the usage rights of a digital work and makes it possible to examine the rights and fees for a digital work without reference to the contents of the digital work. (See Stefik Col. 9, Lines 29-34) The rights portion will contain a data structure, such a look up table, wherein the various information associated with the right is maintained. (See Stefik Col. 10, Lines 6-9), and it is "fundamental to the invention that the usage rights are treated as part of the digital work", so the usage rights can be transported with any copy of the digital work. (See Stefik Col. 11, Lines 32-40). These usage rights are defined in a high level "usage rights language" to define usage rights associated with digital works and their parts. (See Stefik Col. 17, Lines 52-55). These usage rights can include the need for a ticket to access the digital work, this ticket must be presented to a digital ticket agent who can punch the digital ticket before access can be gained to a digital work. (See Stefik Col. 22, Line 60-Col. 23, Lines 14)

In contrast, Chang is directed to a methodology for managing leases on system resources within a distributed computing environment, wherein a resource is a portion of a computer system's physical units, logical units, or functionality. These physical and logical resources do not have the usage and distribution patterns of the digital works of Stefik. The resources of Chang exist in a distributed computing environment. (See Chang, Summary of the Invention, Paragraph [0032]) In an environment such as this a software program that has received use of a logical resource has no need to further distribute that resource. These distributed resources are a way of executing logic or functionality on one computer, and after that functionality is executed the distributed local resource may be released, after which the resource may be leased to another software program or user. (See Chang FIG. 9, Paragraph [0087]) Thus, the resources of Chang may be serially assigned to different users, and each of these system resources may be heavily in demand.

To illustrate further, in the system resulting from the application of Stefik to the software object of Chang each software object would need to be associated with a description tree associated with it. This description tree would contain the usage rights of the invokable software object that make it possible to examine the rights and fees for the invokable software object without reference to the contents of the digital work. The description tree could contain a data structure, such as a look up table, wherein the various information associated with the rights are maintained. This usage tree, in many cases, would be larger than the invokable software object itself, and would have to be passed each time the invokable software object is passed to another. The need to pass this usage tree along with the invokable software object would increase the time it takes to pass the invokable software object, take up more memory, decrease the efficiency and in general place an unneeded burden on the resulting system.

Additionally, every resource within a system which wishes to access the invokable software object would need to obtain a digital ticket, forward this digital ticket to a digital ticket agent before the invokable software object can be accessed or used. Again, the need to pass this digital ticket along with the invokable software object would increase the time it takes to pass the invokable software object, take up more memory, decrease the efficiency and in general place an unneeded burden on the resulting system.



Consequently, the application of Stefik to the software object of Chang has requirements that result in a needlessly complex system for regulating the use and distribution of an invokable software object which will not be further distributed.

### **3.4 Examiner Has Failed To Show Suggestion Or Motivation To Combine References**

As noted above, in order to make a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (See M.P.E.P. 2143). The Examiner implies that it would have been an obvious matter of engineering design choice to apply the invention of Stefik to share invokable software objects (e.g., by stating that “it is known at the time of the invention to share/lease invokable software objects” and “it would have been obvious for one of ordinary skill in the art to apply Stefik’s teaching to control distribution of any type of digital work, including...invokable software objects”). While the Examiner cites two passages of Stefik (See Stefik Abstract, Col. 4, Lines 6-14) as motivation to combine the Stefik and Chang references, these passages serve only to describe the functionality of the invention of Stefik, not to suggest that it would be desirable to apply the invention of Stefik to invokable software objects to enable the owner of a software object to specify usage and distribution rights to a software object. (See *In re Garrett*, 33 BNA PTCJ 43 (November 12, 1986); *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995)).

Contrary to the Examiner’s assertion, there is simply no suggestion in the Stefik reference to modify its own structure to be applied to the invokable software objects of Chang. The invention of Stefik is intended to share digital works between users, where these digital works may be copied and simultaneously accessed. In contrast, the invention of Chang is intended to serially lease resources to users in a distributed system (See Chang FIG. 9). The knowledge generally available to one of ordinary skill in the art taught that, in the distributed system domain, a system for distributing system resources should employ as low an overhead as possible protection by avoiding the overhead of systems such as the one presented in Stefik, as elaborated on above. As there is no direct teaching in Stefik to modify its own structure with the teachings or software objects of Chang, and the knowledge of one of ordinary skill in the art would not have taught the combination of the Stefik and Chang references, the suggestion/motivation criterion of M.P.E.P. 2143 is not met.



### **3.5 Unacceptable Performance of System of Stefik Applied to Chang**

The example elaborated on above in Section 3.4 also makes it clear that, in the specific case of the present system for sharing invokable software objects in a portal framework, the Stefik and Chang references could not be combined to form an improved, or additionally even a workable system. Because the overhead associated with distributing an invokable software object would most likely not be acceptable, the system based on the combination of these references would likely not be usable, and would most likely result in a system unable to distribute its resources quickly enough to be usable, and certainly a system which would not be cost effective or efficient. The system would therefore not be considered a successful result of the combination of the references.

### **3.6 Examiner Has Failed To Show Reasonable Expectation Of Success**

In addition to the suggestion/motivation criterion, the Examiner must show that there is a reasonable expectation of success in combining the references (see M.P.E.P. 2143). As explained above, the Examiner's suggested application of the Stefik system to the software object of Chang would use a description tree (Stefik's implementation) containing the usage rights for every system resource. As described in Stefik such a description tree would contain a data structure, such as a look up table, wherein the various information associated with the system resource is maintained. As also explained above, the overhead for this type of system would be substantial, and would increase with the number of system resources. Consequently, even if, arguendo, a person of ordinary skill were motivated to modify Stefik as suggested by the Examiner, there would be no reasonable expectation of an improved system. In other words, the overhead and complexity of the system suggested by the Examiner would be so great as to make the system ineffective. Thus, the reasonable expectation of success criterion of M.P.E.P. 2143 is not met.

## **4. Examiner Has Failed To Make A Prima Facie Case Of Obviousness Under 35 U.S.C. §103**

Because the Examiner has failed to show that the prior art references teach or suggest all the claim limitations, that there was a suggestion or motivation to combine the Stefik and Chang references in spite of the contrary teachings, or that there was a reasonable expectation

of success in combining the references, the Examiner has failed to meet the criteria set forth in M.P.E.P. 2143 for a prima facie case of obviousness. Accordingly, the Appellant requests that the rejection of the claims under 35 U.S.C. §103 be withdrawn.

## 5. Conclusion

As explained above, the Appellant believes the Examiner has failed to make a prima facie case of obviousness under 35 U.S.C. §103, and that the corresponding rejection of claims 1-44 should properly be withdrawn. The Appellant therefore respectfully requests that all of the rejections be withdrawn and that all the pending claims be allowed. While Applicant believes no further fees are due and owing, if Applicant is in error, the Commissioner is hereby authorized to deduct the appropriate amount from Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully Submitted,  
**Sprinkle IP Law Group**

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